

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN W. MASTERS, MATTHEW PIETRAFITTA
and THERESE VELDE

Appeal No. 2005-1380
Application No. 09/944,314

ON REQUEST FOR REHEARING

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before WALTZ, KRATZ and PAWLIKOWSKI, Administrative Patent
Judges.

WALTZ, Administrative Patent Judge.

REQUEST FOR REHEARING

Pursuant to the provisions of 37 CFR § 41.52(a)(1)(2004), appellants have submitted a Request for Rehearing dated October 24, 2005 (hereafter "Request"), of the decision in Appeal No. 2005-1380 dated September 14, 2005 (hereafter the "Decision"), where the examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) over the applied prior art references were affirmed (Decision, pages 3-4).

Appellants request rehearing based on two grounds, namely that the claim construction in the Decision does not take into account the viewpoint of the person skilled in the art and the section 103(a) rejection lacks proper support (Request, page 1).

With regard to the first ground, appellants argue that the claims do not read on the cited references when the terms of the claims are properly read in the context of the application (Request, page 1). Specifically, appellants argue that (1) the phrase "hearing instrument" has special significance in the art; (2) the term "texture" has not been properly construed; and (3) the term "imparting" has not been properly construed (Request, pages 2-3). We consider each argument below.

Appellants argue that the records of the Office demonstrate that "hearing instrument" is a term of art (Request, page 2, citing also the Reply Brief, page 2). However, this argument was not raised in the Brief or Reply Brief (page 2 of the Reply Brief merely argues for a narrow construction of "hearing instrument" to only include devices "inserted in a user's ear"). Therefore such an argument is not permitted in the Request for Rehearing. See 37 CFR § 41.52(a)(1)(2004); *In re Kroekel*, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed. Cir. 1986) (Failure of appellant to

present an argument before the Board prior to a request for rehearing constitutes a waiver of such argument).

Appellants argue that those skilled in the art of designing and manufacturing devices which assist the hearing impaired would not understand the term "texture" to mean a smooth surface, when read in the context of the specification, which describes the reason for the problem facing appellants was a smooth surface (Request, page 2). Appellants assert that nowhere in the specification did they admit or state that a "textured" surface is smooth but rather appellants "have disclaimed" a smooth surface (*id.*). Appellants further argue that reliance on Marks' Handbook is "misplaced" in construing the term "texture" since the specification states that a smooth surface is the cause of the problem (*id.*). Finally, appellants argue that the term "texture" would not mean an external cover having no contact with the ear canal (as in the Hoerkens reference) nor include the ribs of Widmer as they are "clearly too large and widely spaced" to be considered the "texture" (Request, paragraph bridging pages 2-3).

Appellants' arguments are not persuasive of error in our Decision. Appellants assert that they "have disclaimed" a smooth surface (Request, page 2) but, as noted in our Decision (page 6), there must be a clear disclaimer in the specification.

Appellants' specification discloses that a "[v]ariety of textures" may be used with hearing instrument shells, defining "texture" as "a series of lines 50, equally or unequally spaced ... or some other pattern, predetermined or randomly generated" (specification, page 5, ll. 1-6). The textures used may be non-smooth (specification, page 2, l. 8) or include a "finer" pattern such as a matte finish (specification, page 6, ll. 2-3). Finally, appellants teach that the "actual characteristics of the texture employed may be quite varied" and are a "matter of design choice and suitability to the application," noting that the particulars of surface texture are "well established" and discussed in *Marks'* (specification, page 6, ll. 12-17). As noted on page 8 of our Decision, *Marks'* teaches that surfaces that are polished still exhibit a "texture," thus indicating that the term "smooth" has various relative degrees and may include on some scale a "textured" surface. Thus we find no clear disclaimer in appellants' specification of "a smooth surface."¹ Similarly, we do not find our reliance on *Marks'* "misplaced" since appellants

¹We also note the format of the claims on appeal, with several dependent claims reciting "a non-smooth texture" (see claims 2 and 10). Thus the scope of the independent claims must be broader than these dependent claims, and include other than non-smooth textures (see 35 U.S.C. § 112, fourth paragraph).

specifically cite this reference for its discussion of the "well established" particulars of surface texture, i.e., what one of ordinary skill in this art would have known about surface textures. Furthermore, the definition of "texture" disclosed in the specification does not limit the size and spacing of any lines that constitute "texture," and thus the ribs of Widmer are included within the scope of the claims on appeal (Hoerkens is included due to the construction of "imparting" as discussed below).

Appellants argue that the step of "imparting," when read in the context of the specification, means a modification of the shell surface per se (Request, page 3). Appellants further argue that resort to a dictionary definition contrary to the usage of the term in the specification is improper (*id.*).

Appellants' arguments are not persuasive. As discussed in our Decision (page 9), there is no definition of the term "imparting" in appellants' specification and thus we must resort to a dictionary definition which "comports with the context of the word 'imparting' as used throughout the specification." Decision, page 9. Accordingly, we determine that the claim construction is proper. We find no express disclaimer of the scope of this term to limit the meaning to the preferred

embodiment disclosed, namely modification of the hearing instrument shell per se. *See In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); see also *Comark Commc'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998).

Appellants argue that the correct standard has not been discussed or applied (Request, page 3). This argument is not persuasive since the ordinary and common meaning of the disputed limitations is clear from the specification or other evidence. Furthermore, the Decision relied on *Marks'* as appellants' own evidence in their specification of what one of skill in the art would know about "texture" (Decision, pages 7-8). Appellants argue that such reliance is "misplaced" (Request, page 2) while later arguing that it is required that the terms be read in the context of the specification from the vantage point of those in the art (Request, page 3).

With regard to appellants' second ground, appellants argue that the cited portions of Hoerkens do not address the issues raised in appellants' application (a non-slip surface for the shell) nor do the references provide a motivation or reason for modifying Widmer in the manner proposed by the rejection (Request, page 4).

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These arguments were addressed in our Decision, since these same arguments were made in the Brief and Reply Brief (Decision, pages 13-14). Accordingly, we adopt our comments as noted in the Decision. Additionally, we note that the pleats/waveforms disclosed by Hoerkens ensure that the screen has high flexibility and adequate stability, thus allowing the ornamental ear insert to be retained in the external ear (Hoerkens, col. 1, ll. 45-56), as well as permitting the hearing aid to be worn inconspicuously.

For the foregoing reasons, we do not find in the Request any argument convincing us of errors in the conclusions reached in the Decision. Accordingly, appellants' Request for Rehearing is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

DENIED

Thomas A. Watt

THOMAS A. WALTZ
Administrative Patent Judge

Pete F. Kind

PETER F. KRATZ
Administrative Patent Judge

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INTERFERENCES

Beverly A. Lawrence

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

TW/rwk

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830